

Response to Office Action dated July 28, 2008
U.S. Ser. No. 10/596,298
Berger et al.
Page 6

REMARKS

Summary of the Office Action

Claims 1-19 are currently pending. In the Office Action mailed April 30, 2009 the Examiner rejected claims 1-19 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The Examiner also rejected claims 15-19 under 35 U.S.C. §112, second paragraph as being indefinite. With respect to the prior art, the Examiner rejected claims 1-5 and 9-19 under 35 U.S.C. §102(b) as being anticipated by Harada et al. (U.S. Patent U.S. Patent 5,522,466). The Examiner also rejected claims 1-5 and 9-17 under 35 U.S.C. §102(b) as being anticipated by U.K. Patent Application 2 171 045 (hereinafter U.K. Application ‘045). Claims 5-8, 10-13, 18, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Harada et al. or U.K. Application ‘045 in view of Dunn (U.S. Patent 5,833,014). Applicant has amended claims 1, 15, and 16 to clarify and further define that which is called for therein. As amended, Applicant believes claims 1 and 16, and the claims that depend therefrom, are patentably distinct over the art of record.

§112 Rejections

The Examiner rejected claims 1-19 under 35 U.S.C. §112, first paragraph asserting that, the amendment of claim 1 to recite that the guide device is disposed between the handle and the housing so as to allow relatively uninhibited movement of the handle device relative to the handle housing in the working direction, is not originally set forth in the application. Applicant respectfully disagrees.

The Examiner maintains that, although such conditions can be inferred, such disclosure is not explicitly set forth. The Examiner further alleges that “the specification teaches the contrary.” The Examiner cites page 7, lines 15-17 and page 8, lines 18-21 to support the conclusion that guide device is disclosed as enabling a guided interaction between the hammer housing and the handle device in the working direction, as well as a rotational direction and that the rollers are disclosed as being elastic so as to allow such transverse movement between the handle and the housing. The Examiner further asserts that spring 13 would also inhibit longitudinal movement of the handle relative to the housing. Although MPEP §2163 expressly authorized inherent disclosure as fulfilling the written description requirement, Applicant respectfully disagrees that the specification does not explicitly disclose that which is called for in the present claims or that the disclosure cited by the Examiner is contrary to the language of the claims.

Claim 1 recites that the rolling element devices (8, 9) allows relatively uninhibited movement of the hammer housing relative to the handle device in the working direction (A), and inhibits lateral and rotational movement between the hammer housing and the handle in directions other than the working direction (A). Similarly, claim 16 recites that the rollers called for therein permit movement of the handle cover relative to the hammer housing along the longitudinal axis of the handle cover, i.e. the working direction (A), while at least substantially preventing lateral movement of the handle cover relative to the hammer housing. That is, claims 1 and 16 do not recite that the rolling elements or rollers eliminate lateral and rotational

Amendment/Response to Office Action mailed April 30, 2009

U.S. Patent Application Ser. No. 10/596,298

Inventor(s): Berger et al.

Page 8

movement between the hammer housing and the handle device, only that the rolling devices

inhibit or substantially prevent the lateral and/or rotational movements therebetween.

As clearly set forth in the paragraph traversing pages 6 and 7 of the specification, “guide device 7 enables at least a linear guiding of handle cover 1 relative hammer housing 2 in a working direction A … of the hammer.... The paragraph continues disclosing that, “[P]referably [the guide device] also enables a guiding of handle cover relative to hammer housing 2, transverse to the working direction, and in a rotational direction about the percussion axis oriented in the working direction.” Such disclosure supports the language of the claims directed to the inhibition of the rolling device to impede longitudinal movement of the hammer housing relative to the handle device, i.e. a working direction A, as recited in the claims.

The paragraph at the bottom of page 7 of the specification further describes one embodiment of the invention wherein a spring device presses the rolling elements against a guide track. The paragraph concludes stating that, “In this way, the transverse mobility of handle cover 1 relative to hammer housing 2 can be set in a particularly precise manner.” Said in another way, the rolling devices allow limited lateral and rotational movement between the hammer housing and the handle device. The rolling devices do not wholly prevent lateral or rotational movement between the handle device and the hammer housing but limit and/or inhibit such movement but do so in a “particularly precise matter.” The paragraph at the top of page 8 of the specification describes an alternate embodiment wherein the roller devices are formed “of an elastic material, so that they have a certain degree of deformability in their radial direction.” The paragraph

further states that “In this way, it is possible for handle cover 1 also to be capable of movement transverse to handle housing 2, against the spring action of the elastic material of plastic rollers 9a.” Such disclosure, when considered in conjunction with the disclosure of the figures, evidences, contrary to the Examiner’s assertion, the express disclosure that the rolling devices allow uninhibited movement between the hammer housing and the handle device in the working direction while inhibiting or only substantially preventing lateral or rotational movement therebetween. In view of the above disclosure, those skilled in the art will appreciate the inhibited or substantially prevented lateral and/or rotational movement between the hammer housing and the handle device as a function of the compliance of the spring device and/or the elasticity of the rolling devices.

The Examiner’s further assertion that “spring 13 would also be effective to inhibit longitudinal movement of the handle relative to the housing” is immaterial to the rejection at hand. Applicant does not necessarily disagree that spring 13 interferes with uninhibited motion between the handle device and the hammer housing. However, claims 1 and 16 recite that the *rolling devices* do not inhibit longitudinal motion between the hammer housing and the handle device. The claims *do not* recite that there is *no restriction* in the working direction between the handle device and the hammer housing, rather that the rolling devices or rollers do not contribute to impeding such movement. As supported above, Applicant believes that which is called for in the pending claims is fully and explicitly disclosed in the specification as filed. According,

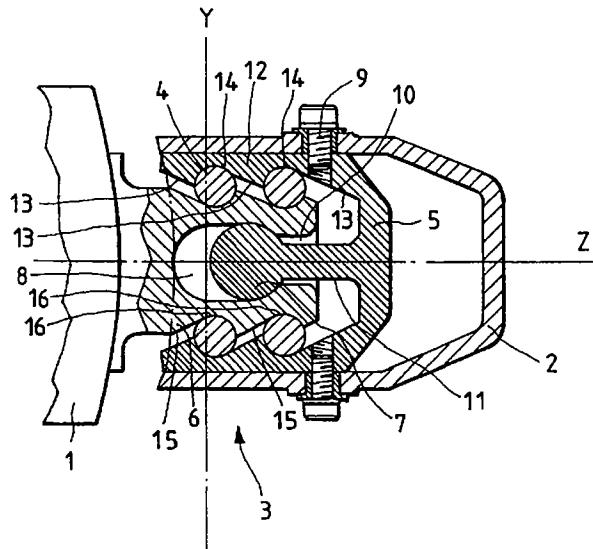
Applicant respectfully requests that the rejections under 35 U.S.C. §112 be withdrawn as improper.

Prior Art Rejections

The Examiner rejected 1-5 and 9-17 as being anticipated by Harada et al. and rejected claims 1-5 and 9-17 as being anticipated by U.K. Application '045. Applicant has amended claims 1 and 16 to further define that which is called for therein. As amended claim 1 calls for, in part, that the rolling elements disposed between the hammer housing and the handle device are supported by an axle that is attached to one of the hammer housing and the handle device. In a similar manner, claim 16 calls for, in part, that each roller is associated with an axis of rotation that is positionally fixed with respect to one of the handle cover and the hammer housing between which the rollers are positioned.

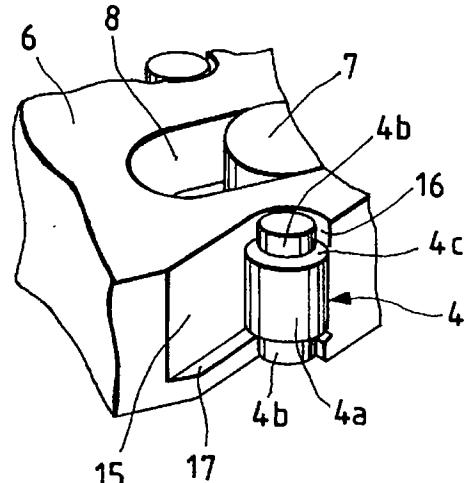
As more fully supported in Applicant's previous response, Harada et al. discloses a vibration dampening structure that allows limited translation of handle 2 relative to tool body 1. As best shown in Figs. 2, 4, and 5 of Harada et al., figures 2 and 5 being reproduced at right and below, rolling elements 4 are captured between

FIG. 2



elastic dampening members 5 and 6. As clearly shown in Fig. 5 of Harada et al., rolling elements 4 are not supported by an axle or other support structure and are captured between the dampening members 5, 6. Harada et al. discloses that dampening members 5, 6 translate relative to one another so that rolling elements 4 translate relative to inclined surfaces 13 and 15 of dampening members 5 and 6 "while allowing rolling motion [of rolling elements 4] to exhibit non-linear spring characteristics. C. 3, l. 59 to c. 4, l. 1. As such, not only does Harada et al. not disclose providing an axle for supporting the rolling elements, but teaches away from such a construction in disclosing that the rolling elements 4 can roll relative to inclined surfaces 13 and 15. Accordingly, Applicant believes claim 1, and the claims that depend therefrom, are patentably distinct over Harada et al.

FIG. 5

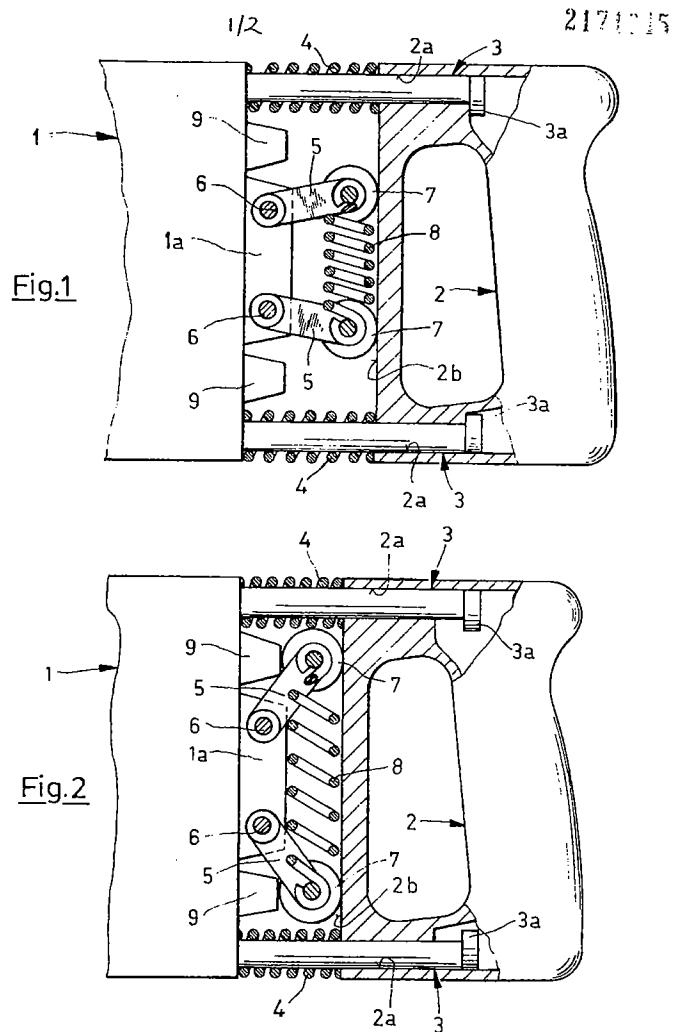


Similarly, as rolling elements 4 are moveable along each of inclined surfaces 13 and 15, Harada et al. does not disclose or remotely suggest rolling elements being associated with an axis of rotation that is positionally fixed with respect to at least one of a hammer housing and a handle device as defined by claim 16. Comparatively, Harada et al. discloses an assembly wherein the axis of rotation of rolling elements is moveable relative to each of inclined surfaces

13, 15. Accordingly, Harada et al. not only does not disclose that which is called for in claim 16, but teaches away from such a construction in disclosing that the rolling elements rotate along relative to each of inclined surfaces 13 and 15. As such, Applicant believes claims 16, and the claims that depend therefrom, are patentably distinct over Harada et al.

U.K. Application '045 discloses an assembly for isolating transmissions of vibrations between a percussion tool and a handle that includes a number of rollers that operate in a similar manner. As best shown in Figs. 1 and 2 of U.K. Application '045, as reproduced below, rollers 7 are movable in outward directions relative to a longitudinal axis of tool 1 and handle 2.

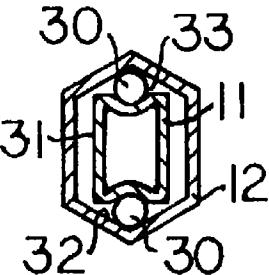
Rollers 7, as well as the axle and axis of rotation of rollers 7, must be movable relative to tool 1 and handle 2. If either the axis of rotation or the position of rollers 7 were fixed relative to tool 1 or handle 2, the rigid connection associated with links 5 would prevent longitudinal translation between tool 1 and handle 2. As such, U.K. Application '045 does not disclose or remotely suggest the rolling element arrangement as defined



by claims 1 and 16. Therefore, Applicant believes claims 1 and 16, and the claims that depend therefrom, are patentably distinct with respect to the art of record.

The addition of Dunn adds nothing to the disclosures of Harada et al. or U.K. Application '045 to overcome the deficiencies discussed above. Although Applicant still is of the opinion that the assembly of Dunn is unrelated to the present invention, as best shown in Fig. 3 of Dunn as reproduced at right, Dunn discloses a number of spherical linear bearings 30 that are captured in a channel between longitudinal extension 11 and sleeve handle 12. Accordingly, Applicant believes claims 1 and 16, and the claims that depend therefrom, are patentably distinct over each of Harada et al. or U.K. Application '045, either alone or in combination with Dunn.

FIG 3



Amendment/Response to Office Action mailed April 30, 2009

U.S. Patent Application Ser. No. 10/596,298

Inventor(s): Berger et al.

Page 14

Therefore, for the reasons set forth above, Applicant believes claims 1-19 are patentably distinct over the art of record. Accordingly, Applicant respectfully requests a notice of allowance of claims 1-19. Although no fees are believed due for entry and consideration of this communication, the Director is authorized to direct payment of any necessary fees, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is cordially invited to contact the undersigned if any informal matters remain which may hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,


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